

**Remarks**

Applicant has amended Claims 1, 7, 14 and 20. No new matter is added by this Amendment. Entry of this Amendment, and favorable consideration thereof, is earnestly requested.

The Examiner has rejected Claims 14-17 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,556,115 to Benson ("the '115 patent"). The Examiner has also rejected Claims 1-13 and 18-20 under 35 U.S.C. 103(a) as being unpatentable over the '115 patent. These rejections are respectfully traversed.

**Rejections under 35 U.S.C. §102(b)**

Claims 14-17 as amended require, among other limitations, a second portion along said outer edge of said hair band, wherein said second portion is frustoconical in shape and extends upwardly from said outer edge terminating at a generally circular retaining lip circumscribing an opening.

Applicant respectfully submits that the '115 patent does not anticipate the Claims 14-17 because all of the elements in the rejected claims are not disclosed in this cited reference. In particular, the '115 patent fails to disclose a portion being frustoconical in shape and extending upwardly terminating at a generally circular retaining lip circumscribing an opening.

The '115 patent teaches a coiffure protector in the form of a cap as worn on the head of a lady. (col. 2, lines 36-38). The coiffure protector is designed to protect "the bouffantness of a coiffure while the wearer thereof is resting or sleeping." (col. 1, lines 66-68). "The protector 10 is formed of two substantially identical, rectangular sections 12 and 13 of permeable material such as a tulle netting or the like." (col. 2, lines 38-42). The '115 patent does not teach or suggest a hair retainer having a frustoconical

shape or an opening. To the contrary, the '115 patent teaches a protector having substantially parallel side segments 17 and 19 and a closed top. (FIG. 4).

It is well settled that "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As the '115 patent fails to disclose a second portion being frustoconical in shape and extending upwardly terminating at a generally circular retaining lip circumscribing an opening, Claims 14-17 cannot be anticipated by the '115 patent.

#### **Rejection under 35 U.S.C. §103(a)**

Claims 1-6 and 20 as amended require a hair retainer extending upwardly and terminating at a generally circular retaining lip circumscribing an opening, said lip having a diameter and said upper edge having a diameter smaller than the said lip diameter to form a frustoconical collar for retaining hair. Claims 7-13 as amended similarly require an annular hair retainer extending upwardly and terminating at a generally circular retaining lip circumscribing an opening, said hair retainer being frustoconical in shape. Finally, Claims 18-19 depend from amended Claim 14 and therefore require a second portion being frustoconical in shape and extending upwardly and terminating at a generally circular retaining lip circumscribing an opening.

As the Examiner correctly points out, the '115 patent does not disclose the elastized portion being annular, the hair retainer being frustoconical in shape when the band is expanded, the lip be circular, an upper edge's diameter being smaller than a diameter of the lip and the material of the still material being mesh and fabric being terycloth. (Office Action, page 3). However, the Examiner states that such limitations

would have been obvious "since such modifications would have involved a mere change in the size and shape of the component." (Office Action, page 3).

"To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The Applicant respectfully submits that the Examiner has failed to supply a sufficient line of reasoning or support in the prior art to show why such modifications would have been obvious.

Further, it is well settled that the mere fact that references can be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In the present case, Applicant respectfully submits that the prior art both fails to suggest the desirability modifying the invention taught by the '115 patent to include the above-mentioned limitations and such modifications would render the invention unsatisfactory for its intended purpose.

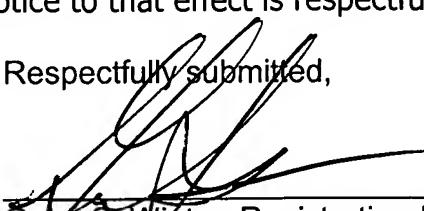
The invention taught by the '115 patent is designed to protect "the bouffantness of a coiffure while the wearer thereof is resting or sleeping" and "protect the bouffant of the coiffure from being crushed." (col. 1, lines 66-68; col. 2, lines 5-6). To achieve this protection, the '115 patent teaches a protector having a top wall and/or top having at least a double layer of material for maintaining the shape thereof. (col. 4, lines 2-3, 35-37; FIGS. 1, 3, 4). Nowhere does the '115 patent suggest the desirability of a frus-

toconical shape extending upwardly and terminating at a generally circular retaining lip circumscribing an opening as required by the rejected claims. In fact, modifying the invention of the '115 patent to include these limitations would render the invention completely unsatisfactory for its purpose of protecting one's hairstyle from being crushed while resting or sleeping.

Moreover, the '115 patent teaches away from the open top hair retaining device of the present invention. A *prima facie* case of obviousness may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). The invention as described and claimed in the '115 patent is a protector or cap in the shape of a substantially cubical bank. (col. 2, lines 46-49). The cap includes a "top wall" and/or "top having at least a double layer of material for maintaining the shape thereof." (FIGS. 1-4; col. 4, line 2, lines 35-38). The rejected claims do not include any such top wall or top. To the contrary, all of the rejected claims require a hair retaining device terminating at a generally circular retaining lip circumscribing an opening. In view of the above, the Applicant respectfully submits that Claims 1-13 and 18-20 as amended are not unpatentable over the '115 patent.

It is respectfully submitted that Claims 1-20, all of the pending claims, are in order for allowance, and early notice to that effect is respectfully requested.

Respectfully submitted,



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